

35. (New) The kit as defined in claim 34, wherein said second outer portion has a width less than the width of said puck.

REMARKS

In reply to paragraph of the outstanding Office Action, the Applicant has renumbered the claims and corrected the claim dependencies. Further, by this Amendment the Applicant has amended claims 1,10, 12, 15, 16 and 22. New claims 23 - 35 have been added. The Examiner has indicated that claims 17 - 20 are allowed.

Claims 1, 10 and 22 have been amended to recite that the Applicant's training pucks each have substantially the same size, shape and weight as a conventional ice hockey puck. Support for this amendment is found in paragraph 0027 of the application. It is apparent from the patent specification that the Applicant's pucks are intended to have the same physical characteristics as regulation pucks except for their coloration. Claims 12, 15 and 16 have been amended to change the dependencies of the claims only.

The Examiner has initially rejected claims 10 - 15, 21 and 22 under 35 U.S.C 102(b) as being anticipated by US Patent Number 5,284,343 (Bigornia et al.). The Bigornia et al. invention is referred to at paragraph 0008 of the Applicant's application. Bigornia et al. relates to a hockey puck having a hollow body which is filled with removable material to alter the puck's weight for practice purposes. Therefore the Bigornia et al. puck is not intended to have the same size, shape and weight as a regulation puck. Accordingly, it is submitted that Bigornia et al. does not read upon claims 10 or 22 as amended or the claims which depend directly or indirectly thereon.

Bigornia et al. show an embodiment in Figure 5 where the puck has visual line markings that can assist a player in determining the rotational velocity of the puck. The line markings 36 cover both the flat sides and the curved edge of the puck (column 6, lines 11 - 13). With respect to claim 22, it is submitted that the purpose of the line markings is to make it easier to monitor and analyze the spin of the puck rather than to reduce the puck's visibility compared to an all-black puck.

With respect to claims 15 and 16, Bigornia et al. does not disclose any embodiments where a second outer portion (i.e. a relatively dark line marking) is circular or annular in shape. Further, with respect to new claims 29 - 35, Bigornia et al. does not disclose any embodiments where the second outer portion has a diameter less than the diameter of the

puck or where the second outer portion is applied only to flat surfaces of the puck, or only to the curved cylindrical surface of the puck. Moreover, Bigornia et al, does not disclose any embodiments where the second outer portion covers no more than two discrete regions of the puck (new claim 32).

The Examiner has initially rejected claims 10 - 15, and 21 under 35 U.S.C 102(b) as being anticipated by US Patent Number 5,184,820 (Keating et al.). The Keating et al. invention is referred to at paragraph 0009 of the Applicant's application. Claims 10 has been amended as indicated above to provide that the puck has substantially the same size, shape and weight as a conventional regulation ice hockey puck. The Keating et al. puck differs from a standard puck since it includes a plurality of projections which reduce the coefficient of friction of the puck to cause it to move more consistently and rapidly on the ice. In one embodiment shown in Figure 4 the puck may include a band 18 having a color differing from the black of the puck. It is submitted that this feature in fact teaches away from the present invention since the band is intended to enhance rather than reduce the visibility of the puck (column 2, lines 62 - 63). For example, the band may have a pigment added to it to give it a fluorescent, orange or green color differing from the black color (column 2, line 56 - 58). Keating et al. therefore discloses a puck having contrasting dark colors; there is no disclosure of a first outer portion having a relatively light color as recited in claim 10. It is therefore submitted that Keating et al. does not read upon claim 10 as amended or the claims which depend directly or indirectly therefrom.

Further, the Examiner alleges that Keating et al. anticipates claim 11. The Applicant respectfully traverses this objection. Keating et al. does not teach a puck where the comparatively darker portion, having greater visibility on an ice surface, is on the flat circular surface of the puck. Keating et al. also does not disclose a puck where a portion of the puck is white (claim 13) or where the second outer portion is circular (claim 15).

The Examiner has initially rejected claims 1 - 4, and 6 - 8 under 35 U.S.C 103(a) as being obvious to a person skilled in the art in view of Bigornia et al. applied in combination with US Patent Number 3,117,788 (Buonanno et al.). Bigornia et al. is discussed above. Buonanno et al. relates to a puck construction where the weight characteristics of the puck have been altered to by providing a plurality of recesses for receiving inserts B. The inserts change the physical characteristics of the puck to reduce its rollability (column 1, lines 21 - 24). As indicated above, the Applicant has amended claim 1 to provide that the Applicant's pucks have substantially the same size, shape and weight as a conventional regulation pucks. This is important to ensure that the training pucks are similar in terms of puck construction to

the regulation pucks which will be used in game conditions. Neither the Bigornia et al. nor the Buonanno et al. references exhibit this characteristic.

The Examiner has noted that Bigornia et al. and Buonanno et al. show hockey pucks with outer portions having dark and light colors in different ratios. The Examiner has alleged that a person "having both types of pucks is considered to have the claimed kit." However, the Examiner has not provided any reasons why a person would in fact be motivated to have both types of pucks. Moreover, as submitted above, both the Bigornia et al. and Buonanno et al. pucks are not regulation ice hockey pucks. In both cases the pucks have been modified to either change the weight of the puck or otherwise alter the physical characteristics of the puck to inhibit the puck from rolling or standing on end. It is submitted that there would no motivation to include in a kit of hockey pucks for training purposes both pucks which are modified to reduce the rollability of the pucks (Buonanno et al.) and pucks that are not (Bigornia et al.). The Applicant's invention alters only the visibility of regulation pucks for training purposes. Altering other physical characteristics of the pucks, such as their weight or rollability, would degrade their suitability for Applicant's training purposes.

It is therefore submitted that claim 1 as amended does not read upon the combination of Bigornia et al. and Buonanno et al. Further it is submitted that the claims which depend directly or indirectly therefrom, including new claims 23 - 29, do not read upon these references.

The Examiner has initially rejected claims 5 and 9 under 35 U.S.C 103(a) as being obvious to a person skilled in the art in view of Bigornia et al. applied in combination with Buonanno et al. and further applied in view of US patent application publication number 2003/0216199 (Summerfield).

The Applicant notes that Summerfield was published after Applicant's priority date. The Examiner is therefore respectfully requested to withdraw the citation under 35 U.S.C. 103(a) on that basis. Further, as submitted above, there would be no motivation for a person skilled in the art to assemble a kit comprising the hockey pucks of Bigornia et al. and Buonanno et al.. It is similarly submitted that there would be no motivation to assemble a kit comprising Bigornia et al. and Buonanno et al. and further comprising Summerfield. Summerfield allegedly discloses a white puck. However, Summerfield relates to a puck which changes color depending upon the temperature of the puck. Summerfield does not disclose a puck which would remain white under all temperature conditions - such a puck would defeat the purpose of the Summerfield invention. Moreover, even if Bigornia et al., Buonanno et al. and

Summerfield were combined in the manner contemplated by the Examiner, such a combination would not have the features and advantages of the Applicant's kit for the reasons submitted above.

It is submitted that this application is now in conditions for allowance. Favourable action at an early date is respectfully requested.

Respectfully submitted,

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Dated: April 4, 2006


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